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In re Application of
Grabstein, Kenneth H. et al :
Serial No : 09/578,669 :Petition To Review Restriction
Filed : May 25, 2000 :Under 37 C.F.R. 1.144
Attorney Docket No.: 2831-E :

This is in response to applicants petition under 37 CFR 1.144, filed August 25, 2003, requesting review of the Examiner's restriction requirement mailed 02/01/2003. The delay in acting on this petition is regretted.

BACKGROUND

The Examiner instituted a restriction of claims 26-55 into 30 different Groups in an office action mailed 02/01/2002 which was subsequently made final. In particular the following restriction between Groups I and II is at issue:

Group I (original claims 26-29,35-38,40-41,43-44 and 46) drawn to antagonists comprising IL-15 conjugated with a chemical group.

Group II (original claims 26,30-37,39-41,43 and 45-46), drawn to antagonists comprising a mutein of IL-15 conjugated with a chemical group.

DISCUSSION

The application, file history and petition have been considered carefully.

Claim 26 as amended on 24 February 2003, is reproduced below.

Claim 26. (Amended) An antagonist of interleukin-15 (IL-15) activity comprising IL-15 or a mutein thereof,

conjugated with a chemical group that sterically interferes with the ability of IL-15 to transduce a signal through the IL-15 receptor complex, wherein said antagonist is capable of binding to said IL-15 receptor complex.

Page 5 of the specification defines the muteins of IL-15 as follows:

IL-15 muteins or muteins of IL-15 refer to the mature, or native, simian IL-15 molecules having the sequence of amino acids 49- 162 of SEQ ID NO: 1 or human IL-15 molecules having the sequence of amino acids 49-162 of SEQ ID NO:2 that have been mutated in accordance with the invention in order to produce an antagonist of IL-15. Such IL- 15 muteins are capable of binding to the IL- 15Ra subunit, and are incapable of transducing a signal through the B- or y-subunits of the IL-15 receptor complex.

Applicant briefly argues that the restriction between Groups I and II is improper in view of *In re Harnisch* (631 F.2d 716; 206 USPQ 300 CCPA 1980) or that claim 26 is a linking claim and thus Groups I and II should be examined in accordance with MPEP 809 and 809.04. No explanation was provided in support of either of these positions and neither of these arguments, in and of themselves, is persuasive.

On the other hand, the Examiner asserted that Groups I and II were restrictable since the antagonists comprise distinctly different structures (e.g. IL-15 vs. a mutant of IL-15) which result in a separate search of the different molecules. This is not persuasive. A thorough search for any IL-15 mutein would first require a search of IL-15. The Examiner failed to establish undue search burden required for restriction under 35 USC 121. For this reason, the restriction between Groups I and II is improper and will be withdrawn.

DECISION

Applicant's petition to withdraw the restriction requirement between Groups I and II under 37 CFR 1.144 is **GRANTED** for the reasons set forth above.

The finality of the Office action mailed 20 May 2003 has been withdrawn. The application will be forwarded to the Examiner for (1) consideration of the After Final amendment filed 27 October 2003 and (2) preparation a non-final action of claims within in rejoined Groups I and II.

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Petition To Review Restriction

Applicants may request for refund of their Notice of Appeal fees paid on 25 August 2003.

Should there be any questions regarding this decision, please contact Julie Burke, Special Program Examiner, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-0519 or by facsimile transmission at (571) 305-7230.

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